

## REMARKS

Reconsideration of the above-identified application respectfully is solicited on behalf of the Applicants. The claims continue to stand rejected as follows:

- Claims 1, 4, 9, 11-15, 20, 23, 28, and 30-34 under 35 U.S.C. § 102(e) as being anticipated by Miska, U.S. Patent No. 6,541,6989; and
- Claims 2, 3, 5-8, 10, 16-19, 21, 22, 24-27, 29, and 35-39 under 35 U.S.C. § 103(a) as being unpatentable over Miska.

In the previous response filed May 04, 2006, Applicants argued as to independent claims 1 and 20 that in Miska, the gasket (10), as to which the Examiner considers the film (15) of the sheath (14) thereof to be equivalent to the claimed second member, does not appear to be integrally joined to the surfaces (16, 18). Rather, “the gasket is disposed for use between [the] adjacent metal surfaces **16, 18 ...** .” [Miska, at col. 5, ll. 66-67]. Indeed, Miska mentions that, “over time, there is relative movement between the metal surfaces **16, 18** and the gasket **10 ...** .” [*Id.*, at col. 5, ll. 41-42].

The examiner has responded that the term “integral” is sufficiently broad to embrace constructions united by means such as welding and fastening. While that may be, Miska discloses no such mean for uniting the film (15) to the surfaces (16) or (18). Accordingly, as Miska does not appear to disclose the claimed feature that the second member is “integrally joined” to the first member, claims 1 and 20 are submitted to be novel over the art made of record. See *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990), citing *Diversitech Corp. v. Century Steps, Inc.*, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988) (for a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in the single reference); See also *In re Spada*, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990) (rejection for anticipation requires that all the elements of the claimed invention be described in a single reference, and that the reference describe the claimed invention sufficiently to have placed one of ordinary skill in the art in possession of it); and *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) (finding the Board to have erred in ignoring a claimed limitation of which the prior art did not disclose).

Regarding the dependent claims, claims 9 and 28 specify that the second member is “self-bonded” to the first member, such as via the insert molding process mentioned at page 11, lines 11-24 of the specification. Applicants previously have made of record their belief that this feature is neither shown nor suggested in the art currently made of record.

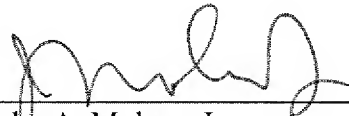
In response, the examiner has referenced Figs. 1 and 3 of Miska. However, and as mentioned, the gasket (10) does not appear to be integrally joined to the surfaces (16, 18). Rather, “the gasket is disposed for use between [the] adjacent metal surfaces **16, 18 ...** .” [Miska, at col. 5, ll. 66-67]. Indeed, Miska mentions that, “over time, there is relative movement between the metal surfaces **16, 18** and the gasket **10 ...** .” [*Id.*, at col. 5, ll. 41-42]. As to Fig. 1, that figure appears

to simply show the gasket (10) as so disposed between the surfaces (16) and (18). Fig. 3 does not even show the surfaces (16,18), so it is unclear how that figure would support the examiner's position.

The remaining dependent claims 2-8, 10-19, 21-27, and 29-39 further describe, respectively, independent claims 1 or 20, and therefore should be considered allowable for the reasons given in connection therewith.

In view of the foregoing remarks, wherein the claim program is believed to have been shown to define the claimed invention as being patentable over art made of record, the issuance of a Notice of Allowance is earnestly solicited. If an allowance of the claims is not forthcoming, please enter this amendment for purposes of appeal.

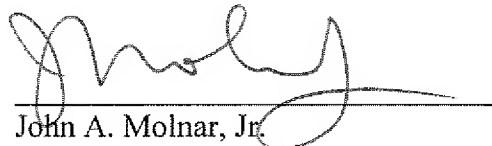
Respectfully submitted,



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I hereby certify that this correspondence is being electronically filed with the United States Patent and Trademark Office on this 05<sup>th</sup> day of December, 2006.



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